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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/722,168

11/25/2003

Wayne L. Pratt

2965.906US03

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24113 7590 07/12/2010
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EXAMINER

LEE, KEVIN L

ART UNIT

PAPER NUMBER

3753

MAIL DATE

DELIVERY MODE

07/12/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/722,168 | Applicant(s) PRATT ET AL. | |
| | Examiner KEVIN L. LEE | Art Unit 3753 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 is/are allowed.
- 6) ☒ Claim(s) 11-24,30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communication filed November 2, 2009. In view of applicant's cancellation of claim 33, the prior rejection of the claim under 35 U.S.C. 102(b) as being anticipated by Yokoyama (US 5,476,118) is now moot and has been withdrawn. The previously indicated allowability of claims 1-24, 30 and 31 is withdrawn in view of the following new grounds of rejection. In light of the new grounds of rejection, the finality of the Office action mailed August 6, 2009 is withdrawn.

Claim Objections

Claims 1-10 are objected to because of the following informalities: The amendment filed November 2, 2009 did not include claims 1-10 in the listing of the pending claims. In addition, the claim status identifier for claims 25-29 and 33 should be "cancelled" instead of "cancel."

In the amendment filed October 9, 2007, applicant has requested that amendments previously proposed for insertion be withdrawn. This request does not appear to be compliant with reissue amendment format. Applicant must re-submit those portions which they had previously amended, in unamended form. The same is true for the drawing changes applicant is trying to withdraw in the amendment of October 9, 2007. It is respectfully suggested that applicant submit a full amendment including the specification with all changes to be made up to this point, likewise for drawings and claims. Appropriate correction is required.

The amendment filed November 25, 2008 proposes amendments to the specification that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. In this amendment of 11/25/08, in a first paragraph of the amendment, applicant has used strikethrough to omit a particular word. For the second and third paragraphs of the amendment to the specification, there is no marking to the changes in these two paragraphs. According to MPEP 1453, "The matter to be omitted by reissue must be enclosed in brackets" and "The matter to be added by reissue must be underlined." Moreover, "Applicant must indicate the precise point where each amendment is made. All bracketing and underlining is made in comparison to the original patent...". A supplemental paper correctly amending the reissue application is required.

Claims 12 and 23 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: Newly added claims 12 and 23 call for "... the internal volume chamber is fluidly coupled with the atmosphere through a weep hole" (emphasis added). Nowhere in the original disclosure is the chamber explicitly or implicitly disclosed to be fluidly coupled with the atmosphere through a weep hole. The original disclosure discloses "A weep hole ... to the space between two diaphragms. This, along with a radial canal just outside the diaphragm seals, provide a means of detecting a leak in the primary diaphragm" (col. 3, lines 9-14). This passage suggests that the weep hole is fluidly coupled to a leak detecting means as opposed to an

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atmosphere. In fact, in claim 1 (limitation (h)) for application 09/556,208 dated 10-27-00, this claim requires optionally connecting a detector to the weep hole. Therefore, contrary to the presently recited claims 12 and 23, the original disclosure suggests fluidly coupling an internal volume chamber to a detector via a weep hole rather than an atmosphere.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation of the internal volume chamber to be fluidly coupled "with the atmosphere" through a weep hole is considered to be new matter not disclosed in the original specification as discussed in the above paragraph.

Claims 11-24, 30 and 31 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45

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USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Applicant's alleged error appears to be recapture since in the original patent, the examiner rejected the originally filed claims on 12/18/2000; in response applicant cancelled those claims, which did not refer to either the drive means or operator means, and submitted new claims which were limited to the drive means and operator means. The claims were then allowed with these added limitations. Applicant is now attempting to remove these limitations via reissue.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

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See MPEP § 1414.01. Applicant is respectfully reminded that the supplemental declaration must be signed by the inventor(s) and NOT the assignee since this is a broadening reissue application.

Claims 1-10 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN L. LEE whose telephone number is (571) 272-4915. The examiner can normally be reached on MONDAY-THURSDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBIN EVANS can be reached on (571) 272-4777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KEVIN L LEE/

Primary Examiner, Art Unit 3753